UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,635	09/23/2003	Keiji Kanota	450100-4804.1	2201

7590 06/30/2005

FROMMER LAWRENCE & HAUG, LLP.
10TH FLOOR
745 FIFTH AVENUE
NEW YORK, NY 10151

EXAMINER	
TRAN, DENISE	

ART UNIT	PAPER NUMBER
2189	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/668,635	KANOTA ET AL.	
	Examiner	Art Unit	
	Denise Tran	2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/261,335.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *9/23/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 22-53 are presented in the application. Claims 1-21 have been cancelled.

2. The disclosure is objected to because of the following informalities: the status of the parent application should be updated.

Appropriate correction is required.

3. Claims 30 and 46 are objected to because they fail to further define the claims from which they depend (1.75). Specifically, the claims from which they depend states that the mediums are logically unified and the above claims then state that they are not logically unified.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim(s) 6, 7, 15, 16 of patent 6,813,681 contain(s) every element of claim(s) 22-53 of the instant application and as such anticipate(s) claim(s) 22-53 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

6. Claims 1-5, 8-14, and 17-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,813,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-24 of the patent do not have a plurality of mediums. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamamoto with Uchida because it would provide for more storage space than is possible for one disc.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 29, 45, and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 29 and 45, the term "said disc-shaped recording medium" lacks proper antecedent basis.

Claim 53, "the ... third data" lacks proper antecedent basis.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 22-25, 29-41, 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al., U.S. Patent No. 6,084,731, hereinafter Uchida, in view of Yamamoto et al., U.S. Patent No. 5,815,333, hereinafter Yamamoto.

As per claims 22, 34, 38 and 50, Uchida teaches the use of an information recording apparatus comprising:

Storing means including a disc-shaped recording medium which are arrangeable so as to have a logically unified first data area for storing information signals therein

(e.g. col. 6, lines 50-60 and col. 5, lines 20-25 and col. 19, lines 39-45, col. 20, lines 38-49 and col. 21, lines 20-35);

Recording means for enabling continuous recording of a first information signal in the first data area (e.g. col. 5, lines 20-25 and col. 19, lines 39-45 and col. 21, lines 20-35).

Uchida does not specifically show the use of plural mediums. Yamamoto shows the use of recording data across plural mediums (e.g. figure 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamamoto with Uchida because it would provide for more storage space than is possible for one disc.

As per claims 23, 35, 39 and 51, Uchida shows the use of a second data area for storing a second information signal (e.g. col. 6, lines 50-60 and col. 5, lines 20-25 and col. 19, lines 39-45 and col. 21, lines 20-35).

As per claims 24, 25, 36, 37, 40, 41 and 52, Uchida shows the use of the second data area is logically unified within the plurality of disc-shaped recording mediums and the second information signal is recorded in the second data area continuously (e.g. col. 5, lines 20-25 and col. 19, lines 39-45 and col. 21, lines 20-35).

As per claims 29 and 45, Uchida shows the use of a HDD (e.g. figure 4).

As per claims 30 and 46, Uchida does not specifically show the use of without logically unifying the first and second data areas of the plural mediums. Yamamoto shows the use of without logically unifying the first and second data areas of the plural mediums. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamamoto with Uchida because it would provide for more storage space than is possible for one disc.

As per claims 31, 32, 47 and 48, Uchida does not specifically show the use of wherein the recording means records at least a portion of the information signals recorded in the temporally continuously. "Official Notice" is taken that both the concept and advantages of providing for recording means for recording at least a portion of information signals recorded in a first data area among the plural data areas in the data areas other than the first data area is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include recording means for recording at least a portion of information signals recorded in a first data area among the plural data areas in the data areas other than the first data area to Uchida because it would provide for duplication of data, thereby allowing the data stored on the disc to recovered in case the first area can not be read or written to and it would provide for continuous recording or playback without the loss of data.

As per claims 33 and 49, it is an inherent limitation of Uchida that the disk is logically unified in response to an actuating input from a user because an actuating input would be the user's command to start to record the data.

11. Claims 26-28, 42-44 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al., U.S. Patent No. 6,084,731, hereinafter Uchida, in view of Yamamoto et al., U.S. Patent No. 5,815,333, hereinafter Yamamoto and in further view of Kanota et al., U.S. Patent No. 5,596,457, hereinafter Kanota.

As per claims 26 and 42, Uchida does not show the use of a first data area is an AV data area, the first information signal is an AV information signal, a second data area is a memo data and the second information signal is a memo data information signal. However Kanota shows the use of a first data area is an AV data area, the first information signal is an AV information signal, a second data area is a memo data and the second information signal is a memo data information signal (e.g. figure 2A). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kanota with Uchida because it would provide for the portability of movies, music or clips on a standard platform (i.e., disc).

As per claims 27, 28, 43, 44 and 53, Uchida does not specifically show the use of a third data area for storing a third information signal which is audio data and an audio

information signal. Kanota shows the use of a third data area for storing a third information signal which is audio data and an audio information signal (e.g. figure 2A). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Kanota with Uchida because it would provide for the portability of movies, music or clips on a standard platform (i.e., disc).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Denise Tran whose telephone number is (703) 305-9823. The examiner can normally be reached on Monday, Thursday, and an alternate Wed. from 8:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Kim can be reached on (703) 305-3821. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Denise Tran

D.T.
June 26, 2005